

AMENDMENTS TO THE SPECIFICATION

On page 24 of the instant specification, please cancel the Abstract of the Disclosure and replace with the following.

ABSTRACT OF THE DISCLOSURE

By obtaining the address of a circuit switching controller in a network with which a mobile station is registered, a packet call controller instructs the circuit switching controller to send notification of when a handoff request is received for a mobile station by the circuit switching controller. The handoff request is for transferring a packet switched call to the circuit switching controller as a circuit switched call. The notification request includes an identifier, which the circuit switching controller uses in notifying the packet call controller of the handoff request. In response to the notification, the packet call controller re-establishes call control and bearer paths between the call endpoints.

Please replace paragraph [0026] with the following new paragraph [0026].

[0026] Fig. 2 illustrates the end point 28 responding to the SIP re-INVITE request according to known SIP procedures. As the call control agent for a call control path from the DV network 30 to the end point 28, the IMS 22 establishes a bearer path from the MSC 34 to the end point 28 over the IP WAN 18 that does not traverse through the IMS 22 according to well-known third party call control procedures for establishing such a bearer path. The MSC interworks the circuit switched call control signaling established between the UE 10 and the MSC 34 with the SIP call control signaling established among the MSC 34, the IMS 22, and the end point 28. The MSC 34 interworks the circuit voice bearer traffic established between the UE 10 and the MSC 34 with the VoIP bearer traffic established between the MSC 34 and the end point 28.

AMENDMENTS TO THE DRAWINGS

The attached "Replacement Drawing Sheet" includes changes to Figure 2. The attached "Replacement Drawing Sheet," replaces the original sheet including Figure 2.

In Fig. 2, the label "U6" has been replaced by the label "UE".

Attachment: Replacement Drawing Sheet

REMARKS

Claims 2-9, and 11-24 are pending in the present application. Claims 1 and 10 are canceled. Claims 2, 3, 8, 11, 16 and 20-22 are amended. New claims 23 and 24 have been added to replace canceled claims 1 and 2, respectively. Applicant respectfully requests reconsideration and allowance of the pending claims in view of the claim amendments and remarks made below.

Applicant thanks and acknowledges the Examiner for indicating that claim 21 contains allowable subject matter.

SPECIFICATION OBJECTIONS

The abstract and specification have been amended to overcome the Examiner's objections thereof.

DRAWINGS

A Replacement Drawing Sheet is being filed to overcome the Examiner's objection thereof.

CLAIM OBJECTIONS

Claim 10 has been canceled, thereby, mooting the Examiner's objection.

CLAIM REJECTIONS – 35 U.S.C. §112

Claim 20 has been amended to replace "call transfer request" with --handoff notification request--.

However, Applicant submits that there is no antecedent basis problem in claim 21. Claim 21 recites in part, “sending a serving controller notification request,” in the second sentence. (Emphasis added.)

CLAIM REJECTIONS – 35 U.S.C. §102

Claims 1-20, and 22 are rejected under 35 USC 102(e) as being anticipated by Ejzak et al. (USP 6,721,565). Applicant traverses this rejection.

The Examiner alleges that, column 11, line 50 to column 12, line 10, disclose “receiving a handoff notification request, the handoff notification request corresponding with a call transfer request if a handoff request is received, the call transfer request requesting transfer of the packet switched call to a circuit switched call,” as recited in new claim 23.

Ejzak et al. discloses that CSCF 152 and MGCF/T-SGW 154, located in a packet domain, cooperate to negotiate a handover with system (circuit domain) 120. (Step 714 of FIG. 7.) The circuit domain 120 allocates radio resources, notifies the packet domain 110, and establishes path 280. (Step 716 of FIG. 7). Under the direction of the packet domain 110, a wireless terminal 140 begins to use the target traffic channel. (Step 718 of FIG. 7).

Applicant submits that nowhere in Ejzak et al. does it suggest or disclose “receiving a handoff notification request from a packet call controller at a network controller of the second network, the handoff notification request instructing the network controller to send a call transfer request to the packet call controller when a handoff request for a mobile station is received by the network controller.” The CSCF 152 and MGCF/T-SGW 154 emulate handover functions. Column 9, lines 14-16. At best, Ejzak et al. discloses “receiving a transfer request” sent by the CSCF 152 and MGCF/T-SGW 154. Claim 23 recites, in part, that a handoff notification request instructs a network controller to send a call transfer request to a packet call controller. Accordingly, Ejzak et al., fails to disclose all the feature of claim 1. Applicant submits that claim 1 is patentable over the

Ejzak et al. reference.

New claim 24 similarly recites the allowable features of claim 23. Specifically, claim 23 recites a method from a perspective of the second network, and claim 24 recites a method from the perspective of the first network. Therefore, claim 24 is also patentable for the same reasons given above with respect to the patentability of claim 23.

Dependent claims 2-8 and 11-20, and 22, are also patentable for the same reasons given above with respect to the patentability of their base claims 23 or 24.

CLAIM REJECTIONS – 35 U.S.C. §103(a)

Claims 1, 3, 8-11 and 22 are rejected under 35 USC 103(a) as being unpatentable over Julka et al. (USP 6,917,810) in view of Ray et al. (USP 6,424,638).

The Examiner notes that Julka et al. does not disclose receiving a handoff notification request, but Ray et al. teaches a handoff notification request, the handoff notification request corresponding with a call transfer request. Column 3, lines 43-65. The Examiner concludes that it would have been obvious to combine the teachings of Julka et al. and Ray et al. Without acquiescing to the Examiner's rejection reasons in view of Julka et al., Applicant disagrees with the Examiner's rejection reasons with respect to Ray et al., and thereby traverses this rejection.

Ray et al. discloses a method of performing a handover between two digital systems, specifically a GSM system and a D-AMPS system. Column 2, lines 49-55. Reciting the same passage, the Examiner alleges "even though, the figure 2A shows MSC and BSC to be the same for the systems shown, Ray et al. makes it clear in the reference that **system can be the same or different** and still be able the communicate." (Emphases added.)

Ray et al. discloses that "different types of systems" may be implemented, but the "different types of systems" may be implemented vis-à-vis figure 1. The entire passage of column 2, lines 49-55, discloses that a Global System for Mobile Communication (GSM) and its **basic**

functionalities are shown in FIG. 1, and that it is the basic functionalities that may be implemented differently by different types of function. Nowhere in the reference does it teach or suggest that the invention of Ray et al. may be implemented differently in different types of systems other than the digital systems disclosed in the specification. In other words, there is no teaching or suggestion that the disclosure of Ray et al. may be implemented on a packet network and/or circuit network.

Applicant submits that the Examiner has failed to show a *prima facie* case of obviousness by failing to show where in the references or in the general knowledge of a person of ordinary skill that it would have been obvious to combine the references, because Ray et al. discloses a handover method between two different digital systems and Julka et al. discloses an inter-MSC packet data handoff.

For at least the reasons given above, Applicant submits that claim 1 is patentable over the combination of Julka et al. in view of Ray et al. Claim 3, 8, and 9, which are dependent to claim 1, are also patentable for same reasons given above with respect to the patentability of claim 1 and for additional limitations recited thereby.

With regards to claim 10, the Examiner alleges that Julka et al. discloses all the feature of claim 10, except for sending a handoff notification request, the handoff notification request requesting sending of a notification if the second network receives a handoff request. However, the Examiner contends Ray et al. discloses such a feature. Column 3, lines 43-65.

As remarked above with regard to claim 1, Ray et al. discloses a method of handover where a serving MSC 14a receives a handover required message, and then the serving MSC 14a sends a handover request message to a target MSC 14b. In other words, Ray et al. discloses sending a handover required message and then sending a handover request message. Ray et al. does not teach or suggest sending a handoff notification request, if the second network receives a handoff request as recited in claim 24. For at the reasons given above, Applicant

submits that claim 10 is patentable over the combination of Julka et al. in view of Ray et al.

Claim 11 and 22, which are dependent claims on claim 24, are also patentable for same reasons given above with respect to the patentability of claim 1 and for additional limitations recited thereby.

Claims 2, 6, 12, 14, 16 and 18-20 are rejected under 35 USC 103(a) as being unpatentable over Julka et al. in view of Ray et al. and further view of Surdila et al. (USPA 2002/0110104).

Claims 2 and 6 are dependent on claim 23, and claims 12, 14, 16 and 18-20 are dependent on claim 24. For at least the same reasons given with respect to the patentability of claims 23 and 24, Applicant submits that dependent claims 2, 6, 12, 14, 16 and 18-20 are also patentable over Julka et al. in view of Ray et al. Applicant further submits that Surdila et al. fails to cure the deficiencies in Julka et al. in view of Ray et al. Therefore, claims 2, 6, 12, 14, 16, and 18-20 are also patentable.

Claims 5, 7, 13, and 15 are rejected under 35 USC 103(a) as being unpatentable over Julka et al. in view of Ejzak.

Claims 5 and 7 are dependent to claim 23, and claims 13 and 15 are dependent to 24, and for at least the reasons given with respect to the patentability of claims 23 and 24, Applicant submits that dependent claims 5 and 7 and 13 and 15 are also patentable. Applicant further submits that Julka et al. fails to disclose the deficiencies of Ejzak as remarked above.

Claims 4 and 17 are rejected under 35 USC 103(a) as being unpatentable over Surdila et al. in view of Faccin et al (US 6,725,036).

The Examiner rejects claim 4 as applied to claim 3. Claim 3 depends on claim 23, and claim 4 is rejected based on Ejzak et al. in view of Julka in view of Surdila et al. and in further view of Faccin et al. For at least the reasons given above with respect to the patentability of 23, claim 4 is also patentable.

The Examiner rejects claim 17 as applied to claim 16. Claim 16 depends on claim 24, and claim 17 is rejected based on Ejzak et al. in view of Julka in view of Surdila et al. and in further view of Faccin et al. As argued above, claim 17 is patentable for at least the same reasons given with respect to the patentability of claim 24.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of claims 2-8, 11-20, 23 and 24 in connection with the present application is earnestly solicited.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant hereby petitions for a one (1) month extension of time for filing a reply to the outstanding Office Action and submits the required \$120 extension fee herewith.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gary D. Yacura at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.


Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By



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